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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/145,987	09/03/1998	YUKIKO NAKANISHI	2224-0142P	6638

2292 7590 05/13/2002

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 05/13/2002

29

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/145,987

Applicant(s)

NAKANISHI ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-18, 20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Amendment G filed February 21, 2002 has been received and entered into the record.
2. Claims 1-13, 15-18, 20 and 22 are pending in the case.
3. All 35 U.S.C. statutes not cited in this Office action can be found cited in full in a previous Office action.
4. The Appeal is being held in abeyance.

Election By Original Presentation

5. Newly submitted Claim 22 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly submitted Claim 22 is directed to a method of producing a cellulose acetate that appears to broader than the ordinarily filed method. Claim 22 was originally directed to a method of producing a cellulose acetate that comprises the features (i), (ii), or (iii) of Claim 1, which is not the case for the newly submitted Claim 22.

Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claim 22 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

35 U.S.C. 102 Rejection

6. Claims 1 and 4-7 stand rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan (US Patent No. 4,426,481) for the reasons already of record on pages 3 and 4 of the Office action mailed August 27, 2001.
7. Claims 1 and 4-7 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ishii et al (US Patent No. 3,816,150) for the reasons already of record on page 4 of the Office action mailed August 27, 2001.

35 U.S.C. 103 Rejection

8. Claims 1-13, 15-18 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan (US Patent No. 4,426,481) in view of Mochida et al (US Patent No. 4,888,147) for the reasons already of record on pages 4 and 5 of the Office action mailed August 27, 2001.

9. Claim 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan (US Patent No. 4,426,481) and Mochida et al (US Patent No. 4,888,147) as applied to Claims 1-13, 15-18 and 20 above, and further in view of Ishii et al (US Patent No. 3,816,150) for the reasons already of record on pages 6 and 7 of the Office action mailed August 27, 2001.

10. Claims 18 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Seo et al (US Patent No. 5,240,665) in view of Ishii et al (US Patent No. 3,816,150) for the reasons already of record on page 5 of the Office action mailed February 25, 1999.

Arguments Not Persuasive

11. Applicant's arguments filed February 21, 2002 have been fully considered but they are not persuasive. After further consideration of the references and the remarks by Applicants in their response filed February 21, 2002, the indication in the interview summary filed January 17, 2002 to withdrawn the rejections over the prior art of record has been withdrawn. Applicants argue against the rejections on the ground that the prior art references used in the rejection of the claims failed to teach the role of the free carboxyl group bonding directly to cellulose acetate. However, Applicants's explanation for the generation of free carboxyl groups that are attached directly to the cellulose for features (ii) and (iii) on pages 8-11 of their response filed February 21, 2002 was not persuasive. On page 8, at the beginning of the 2nd paragraph, Applicants state that "cellulose inherently has carboxyl groups, and thus carboxyl groups of a cellulose acetate are originated from cellulose." This statement is not correct since the structure of cellulose does not contain carboxyl groups. Cellulose is a carbohydrate polymer of 1,4- β -linked glucopyranose units in the walls and skeletons of vegetable cells. Further clarification of this statement is requested. Since features (ii) and (iii) of the claims do not establish a cellulose acetate compound that is distinct

from the cellulose acetate of the prior art of record, the rejection of the claims as being unpatentable over the prior art of record is maintained.

12. **Summary:** Claims 1-13, 15-18 and 20 rejected; Claim 22 is withdrawn from consideration.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Telephone Number, Fax Number, and Other Information

14. For 24 hour access to patent application information 7 days per week, or for filing applications electronically, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached on (703) 308-4532. The fax phone number for this Group is (703) 308-4556.

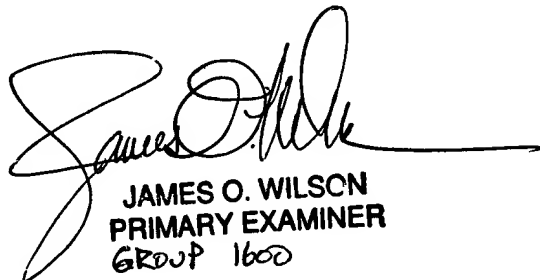
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

White

May 7, 2002



JAMES O. WILSON
PRIMARY EXAMINER
GROUP 1600